UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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#26

In re Application of: :
O'SULLIVAN et al :
Serial No.: 09/091,333 : PETITION DECISION
Filing Date: 12 December 1996 :
Attorney's Docket No.: PI/5-20691/A/PCT :

This is in response to "PETITION UNDER 37 CRF 1.181" filed on March 5, 2002, requesting the declaration of the interference between the present application and U.S. patent 5,679,796 pursuant to 37 CFR 1.607.

BACKGROUND

The present application is a 371 of PCT/EP96/05564 filed 12 December 1996, which claims a priority date of 21 December 1995 based on Swiss application no. 3636/95. The 371 requirements were met on 26 October 1998.

On March 18, 1999 (paper #7), a restriction was mailed; election of a single species under 35 USC 121 was required. It is noted that instant application is a 371 application, examiner should have been used PCT rules to set forth restriction/lack of unity. On May 18, 1999 (paper #10), applications responded and elected formula II with traverse. On June 28, 1999 (paper #11), an Office action was mailed. Examiner rejected claims as not being made prior to one year from date on which US patent '796 was granted. On September 27, 1999 (paper #12), amendment and reconsideration was filed. Applicants requested reconsideration for the following reasons: 1) PTO has neglected to carry its burden for establishing a prima facie case as to why 35 USC 135 should operate in the instant case, and 2) applicants' claim in question were made prior to one year from the date on which US Patent 5,679,796 was issued. In addition, applicants requested

reconsideration of the restriction. On November 5, 1999 (paper #13), a Final rejection was mailed. Claims 1-6, 8, 9, 12 and 13 remain rejected under 35 USC 135(b). Examiner stated that applicants are not entitled to an earlier date of PCT and Swiss applications because applicants failed to comply with 37 CFR 1.495(b). On May 5, 2000, Notice of appeal was filed. On August 10, 2000 (paper #17), an Appeal Brief was filed. The single issue in the final rejection was: Are claims 1-7, 9, 12 and 13 unpatentable under 35 USC 135(b) as not being made prior to ONE YEAR from the date on which U.S. Patent 5,679,796 was issued? On September 20, 2001 (paper #18), an Office action was mailed. Examiner withdrew the finality and indicated that the restriction is proper because reactants, reagents and reaction conditions differ in processes. Examiner suggested an allowable claim for purposes of copying with a 30 day time period. However, Office Action Summary indicated a shortened statutory period for response is set to expire 3 months. On February 22, 2001 (paper #20), a response was filed. Applicant responded to the rejection under 35 USC 112, but did not copy the claim. Applicant asserts that Rule 605(a) requirement is not applicable since applicants' claim 2 directed to "substantially the same invention" as originally filed and that no issue of disclaimer is applicable. On May 18, 2001 (paper #21), an Office action was mailed. Claims 1-7, 9, 10, 12 and 13 are rejected under 102(g). Rejection under 112, 2nd was repeated without and comment. Examiner states that applicants' failure to present claims amounts to a disclaimer of subject matter. On November 19, 2001 (paper #23), an amendment was filed. Applicants copied the claim suggested by the examiner and requested examiner to set up an interference between instant application and the '796 patent. Applicants again argued that 1.605(a) does not apply since there is a claim already present in the application drawn to the same patentable invention. Applicants assert that there is no clear indication there are two different respond periods in the Office action dated September 22, 2000 (paper #18) and that applicants should not be penalized for "hidden" shortened statutory response date which was on the last page of the Office action. Applicants further argue that it is clear that the examiner has conceded that applicants had presented a claim within one year of the issue date of the patent as required under 35 USC 135(b) and withdrew the finality of the rejection. Applicants assert that they are being held to not have complied with a requirement the examiner admits they have already complied with ad requested reconsider and withdraw the rejection under 102(g). In addition, a statement pursuant to 37 CFR 1.607 was provided. On December 21, 2001 (paper #24), a Final action was made and invited applicants to file the instant petition. On March 5, 2002, instant petition was filed. Applicants request the declaration of an interference between the present application and U.S. patent 5,679,796 pursuant to 37 CRF 1.607.

DISCUSSION

The file history and applicants' statement have been carefully reviewed and considered. Instant claim 2 as originally filed directed to "substantially the same invention" and were presented almost a year prior to the issue date of the '786 patent. Thus 37 CFR 1.605(a) does not apply since there is a claim already present in the application drawn to the same patentable invention. However, there is a 102(g) rejection on the record. Under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the

second or final rejection of his or her claims may appeal to the Board for review. Therefore, applicant has an appealable matter. Accordingly, the petition is Dismissed.

Petition Dismissed.

Should there be any questions with respect to this decision, please contact Cecilia Tsang, by mail address to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-0254 or by facsimile transmission at (703) 308-3890.

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